

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 21

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte EDGAR A. DALLAS and PETER B. WHITLOCK

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Appeal No. 2002-0993  
Application No. 09/368,781

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ON BRIEF

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Before STAAB, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 10, mailed May 23, 2001) of claims 1 to 5, 8 to 11, 14 to 16, 19 to 25, 27, 28 and 35 to 44. Claims 6, 7, 12, 13, 17, 18, 26 and 29 to 34 have been canceled. Claims 45 to 49 have not been rejected and according to the examiner stand withdrawn from consideration as

being drawn to a nonelected species, there being no allowable generic or linking claim.<sup>1</sup>

We AFFIRM-IN-PART.

### BACKGROUND

The appellants' invention relates to hand tools with multi-faceted inserts for cutting wire and other materials (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Root	477,066	June 14, 1892
Petersen	2,590,031	Mar. 18, 1952

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<sup>1</sup> Manual of Patent Examining Procedure (MPEP) § 821 provides that (1) all claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration by the examiner; (2) the examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention; and (3) applicant may file a petition under 37 CFR § 1.144 for review of the restriction requirement. In response to a species requirement (Paper No. 8, mailed February 8, 2001), the appellants elected Figure 1 and stated that claims 1 to 5, 7, 8, 10, 11, 14 and 37 to 49 were generic (see Paper No. 9, filed March 12, 2001). However, in withdrawing claims 45 to 49 from consideration in the final rejection, the examiner did not clearly set forth the reasons why claims 45 to 49 were not readable on the elected species of Figure 1. In any event, the withdrawal of claims 45 to 49 from consideration relates to a petitionable matter and not to an appealable matter. See MPEP §§ 1002 and 1201. Accordingly, we will not review the withdrawal from consideration issue raised by the appellants on pages 17-18 of the brief. In addition, the examiner's objection to the drawings under 37 CFR § 1.83(a) raised in the final rejection also relates to a petitionable matter and not to an appealable matter. Accordingly, we will not review the drawing issue raised by the appellant on page 5 of the brief.

Claims 21 and 38 to 44 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 37 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Root.

Claims 1 to 5, 8 to 11, 14 to 16, 19, 20, 22 to 25, 27, 28 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Root.

Claims 35 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Root in view of Petersen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection, the answer (Paper No. 18, mailed November 30, 2001) and the supplemental answer (Paper No. 20, mailed February 19, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed September 21, 2001) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness rejection**

We sustain the rejection of claim 21 under 35 U.S.C. § 112, second paragraph, but not the rejection of claims 38 to 44.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the

claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we analyze the specific reasons set forth by the examiner for the rejection under 35 U.S.C. § 112, second paragraph.

With respect to claim 21<sup>2</sup>, the examiner pointed to various typographic errors as rendering the claim indefinite (answer, p. 4). We agree. The appellants may be correct that the substance (i.e., essence) of claim 21 is clear, however, the meaning of claim 21 in its entirety as currently worded is not sufficiently clear so as to define the metes and bounds thereof with a reasonable degree of precision and particularity. Accordingly, the

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<sup>2</sup> Claim 21 reads as follows:

A wire cutter according to claim 15 wherein said means for non-threadedly connecting said inserts to said lever arms comprises said inserts being comprised at least partially of a magnetic material and at least a portion of said cutting ends being made of a magnetic material. A wire cutter according to claim 15 wherein said g made of a material such that said inserts and said cutting ends are magnetically attracted to one another.

decision of the examiner to reject claim 21 under 35 U.S.C. § 112, second paragraph, is affirmed.

Pursuant to 37 CFR § 1.196(c), we state that claim 21 amended to read as follows:

A wire cutter according to claim 15 wherein said means for non-threadedly connecting said inserts to said lever arms comprises said inserts being comprised at least partially of a magnetic material and at least a portion of said cutting ends being made of a material such that said inserts and said cutting ends are magnetically attracted to one another.

would overcome the rejection under 35 U.S.C. § 112, second paragraph.

With respect to claims 38 to 44, we find ourselves in agreement with the appellants (brief, p. 6) that the metes and bounds of these claims is set forth with a reasonable degree of precision and particularity. Accordingly, the decision of the examiner to reject claims 38 to 44 under 35 U.S.C. § 112, second paragraph, is reversed.

#### **The anticipation rejection**

We sustain the rejection of claim 37 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 37 reads as follows:

A tool for cutting materials, comprising:  
a first lever arm;  
a second lever arm, the second lever arm being coupled to the first lever arm by a pivot assembly; and  
a first insert disposed at least partly within and attached to the first lever arm, the first insert having first and second sides, the first side being tapered to form a first cutting edge, the second side being tapered to form the second cutting edge, the first insert and the second lever arm configured to cooperatively act to cut material disposed therebetween when the angle between the first lever arm and the second lever arm is reduced towards zero.

Root's invention relates to pliers having cutting-jaws and has for its object to provide a tool of this class having removable, interchangeable, and reversible cutters provided with a number of cutting-edges, whereby the cutters can be adjusted to bring a new cutting-edge into play when one edge has become worn, and to enable the substitution of new cutters when desired. Referring to the drawings, A A designate the two members of a pair of pliers. The members A each comprise a handle 13 and a jaw C. Intermediate the jaws and handles and connecting the same integrally are circular disks D D, the latter terminating at their inner faces one-half the breadth of the members A below the open side of the latter, forming circular recesses d d. Thus when the members are in relative position the disks D fit within the respective recesses and turn therein. The members are secured together by a pivotal screw E, passing through a smooth eye e, provided centrally through one of the disks D and secured within a coincident threaded eye e' in the other disk.

H H designate cutting-plates, which are triangular in shape and preferably truncated at the apexes, each of the three edges of the plates constituting an independent cutting edge. The cutting-edges of the plate are formed by beveling the latter from one side, as shown. The cutting-plates are disposed in corresponding sockets or recesses I I, provided in the inner faces of the disks D. Each cutting-plate is provided with a central aperture j for the reception of a securing-screw J, the latter



being screwed into a coincident threaded aperture j' in the disk to secure the cutting-plates within the sockets or recesses.

While the cutting-plates have been disclosed as triangular in shape with three cutting-edges, Root teaches (page 2, lines 18-31) that such shape is not essential and any other angular form of cutter may be employed. For instance, hexagonal cutters may be employed, each having six cutting edges with the cutters being disposed in hexagonal sockets.

The appellants argue (brief, pp. 7-8) that Root's pliers do not anticipate the subject matter of claim 37 since Root's pliers do not include a first insert having first and second sides, the first side being tapered to form a first cutting edge, the second side being tapered to form the second cutting edge. We do not agree.

Claim 37 reads on Root's pliers as follows: A tool for cutting materials (Root's pliers), comprising: a first lever arm (Root's first member A); a second lever arm (Root's second member A), the second lever arm being coupled to the first lever arm by a pivot assembly (Root's pivotal screw E, eye e and threaded eye e'); and a first insert disposed at least partly within and attached to the first lever arm (Root's first cutting-plate H in the first member A), the first insert having first and second sides (Root's first

cutting-plate H has at least five sides (i.e., the three beveled sides forming three-cutting edges, an upper side as shown in Figures 4 and 5 and a lower side as shown in Figure 4)), the first side being tapered to form a first cutting edge (one of Root's three beveled sides on the first cutting-plate H is tapered to form a first cutting edge), the second side being tapered to form the second cutting edge (another of Root's three beveled sides on the first cutting-plate H is tapered to form a second cutting edge), the first insert and the second lever arm configured to cooperatively act to cut material disposed therebetween when the angle between the first lever arm and the second lever arm is reduced towards zero (Root's first cutting-plate H and second member A are configured to cooperatively act to cut material disposed therebetween when the angle between the first member A and the second member A is reduced towards zero).

Since claim 37 is readable on Root, claim 37 is anticipated by Root. Accordingly, the decision of the examiner to reject claim 37 under 35 U.S.C. § 102(b) is affirmed.

### **The obviousness rejection of claim 38**

We sustain the rejection of claim 38 under 35 U.S.C. § 103.

Claim 38 reads as follows:

The tool of claim 37 further comprising: a second insert disposed at least partly within and attached to the second lever arm, the second insert having first

and second sides, the first side of the second insert being tapered to form a fourth cutting edge, the second side of the second insert being tapered to form a fifth cutting edge, the first insert and the second inserts configured to cooperatively act to cut material disposed therebetween when the angle between the first lever arm and the second lever arm is reduced towards zero.

The appellants argue (brief, p. 13) that Root's pliers do not teach or suggest the subject matter of claim 38. We do not agree.

Claim 38 reads on Root's pliers as follows: The tool of claim 37 further comprising: a second insert disposed at least partly within and attached to the second lever arm (Root's second cutting-plate H in the second member A), the second insert having first and second sides (Root's second cutting-plate H has at least five sides (i.e., the three beveled sides forming three-cutting edges, an upper side as shown in Figures 4 and 5 and a lower side as shown in Figure 4)), the first side of the second insert being tapered to form a fourth cutting edge (one of Root's three beveled sides on the second cutting-plate H is tapered to form a fourth cutting edge), the second side of the second insert being tapered to form a fifth cutting edge (another of Root's three beveled sides on the second cutting-plate H is tapered to form a fifth cutting edge), the first insert and the second inserts configured to cooperatively act to cut material disposed therebetween when the angle between the first lever arm and the second lever arm is reduced towards zero (Root's first cutting-plate H and second cutting-plate H are

configured to cooperatively act to cut material disposed therebetween when the angle between the first member A and the second member A is reduced towards zero).

Since claim 38 is readable on Root, claim 38 is anticipated by Root under 35 U.S.C. § 102(b). Affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, the decision of the examiner to reject claim 38 under 35 U.S.C. § 103 is affirmed.

### **The obviousness rejection of claims 35 and 36**

We sustain the rejection of claims 35 and 36 under 35 U.S.C. § 103.

Claims 35 and 36 read as follows:

35. A tool for cutting materials, comprising:  
a first lever arm;  
a second lever arm, said second lever arm being coupled to said first lever arm by a pivot assembly;  
only one insert with multiple cutting edges, said insert disposed at least partly within and attached to said first lever arm; and  
means for severing a material.

36. The tool according to claim 35, wherein said second lever arm includes a cutting end having a flat surface that is generally perpendicular to said insert, and wherein said flat surface is configured such that, when said first and second lever arms come together, said insert comes into contact with said flat surface to sever a material.

The teachings of Root have been set forth above in our discussion of claim 37.

Petersen's invention relates to a wrench of a toggle type provided with wire cutting means making it possible to cut very heavy wire ordinarily impossible to sever by a squeezing action. An object of Petersen's invention was to provide a tool including relatively movable jaws one of which carries an anvil and the other having a cutting edge opposed to the anvil wherein the anvil is provided with a flat working surface whereby the necessity of keeping the anvil and cutting edge in perfect sidewise alignment in order to effect the cutting of a wire is eliminated.

In the embodiment Petersen's invention illustrated in Figures 1 and 2, A denotes an elongated handle member. The outer end portion of the handle A is provided with a stationary jaw 5 with a serrated working jaw face 6. Partially extending within the handle A and partially overlying the inner or adjacent end portion of the working face 6 is an anvil 7. The body of the anvil 7 projects a predetermined distance beyond the working face 6 and has a longitudinally flat working face 9 directed toward the other jaw

12, with which it is adapted to directly coact with the cutting edge of a blade 10 positioned at the inner portion of the working face of a movable jaw 12. The blade 10 is oppositely beveled to provide an elongate cutting edge 14, which has cutting coaction with the face 9 of the anvil 7. The face 9 extends on a line oblique to the jaw face 6 while the edge 14 is substantially parallel to the jaw face 11 of jaw 12.

In the embodiment of Petersen's invention illustrated in Figure 3, the blade 24 carried by the jaw 25 is substantially the same as the jaw 12 as embodied in Figures 1 and 2. Coacting with the blade 24 is a cutter member 26 which is also disposed beyond the working face of the jaw in the same manner as the anvil 7 in Figures 1 and 2. The cutting edge b of member 26 is in direct alignment with the cutting edge c of the blade 24. In the embodiment of Petersen's invention illustrated in Figure 4, the cutting blade or member 27 carried by the jaw 28 is reduced by cutting away as at 29, a portion of the side face of the jaw 28 inwardly so that the same may have close contact with the cutting blade or member 30 carried by the stationary jaw 31 of the wrench.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Root and claim 35, it is our opinion that the only difference is the limitation that the tool has "only one insert with multiple cutting edges" whereas Root's tool has two inserts (i.e., cutting-plates H) with multiple cutting edges.

In applying the test for obviousness,<sup>3</sup> we conclude that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have replaced one of Root's cutting-plates H with an anvil in view of Petersen's teaching of known alternative wire cutters such as a cutter-anvil combination shown in Figures 1 and 2 and the cutter-cutter combinations shown in Figures 3 and 4. In this regard, it must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

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<sup>3</sup> The test for obviousness is what the combined teachings of the applied prior art would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With regard to claim 36, while the further limitations of claim 36 are not taught by Root, the limitations of claim 36 are met when Root is modified by replacing one of Root's cutting-plates H with an anvil as set forth above.

In view of the above determination of obviousness of the subject matter of claims 35 and 36, we find the appellants' argument that the "only one insert with multiple cutting edges" is not suggested by the applied prior art unpersuasive. In addition, the appellants have argued deficiencies of each reference on an individual basis, however, it is well settled that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

For the reasons set forth above, the decision of the examiner to reject claims 35 and 36 and 38 under 35 U.S.C. § 103 is affirmed.

**The obviousness rejection of claims 1 to 5, 8 to 11 and 14**

We will not sustain the rejection of claims 1 to 5, 8 to 11 and 14 under 35 U.S.C. § 103.



Claim 1 reads as follows:

A tool for cutting materials, comprising:  
a first lever arm;  
a second lever arm, said second lever arm being coupled to said first lever arm by a pivot assembly;  
a first insert with multiple cutting edges including at least a first cutting edge and a second cutting edge, said first cutting edge being of greater length than said second cutting edge, said first insert disposed at least partly within and attached to said first lever arm; and  
a second insert with multiple cutting edges including at least a third cutting edge and a fourth cutting edge, said third cutting edge being of greater length than said fourth cutting edge, said second insert disposed at least partly within and attached to said second lever arm such that when the angle between said first lever arm and said second lever arm is reduced towards zero, said first insert and said second insert cooperatively act to cut material disposed therebetween.

The appellants argue that the applied prior art does not suggest the claimed subject matter of claim 1. We agree.

Claim 1 requires both the first and second inserts to have cutting edges of different lengths. However, Root teaches and suggests only inserts with cutting edges of equal length. To supply this omission in the teachings of Root, the examiner made a determination (final rejection, p. 3; answer, p. 5) that these differences would have been obvious to an artisan. However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Since there is no evidence in the rejection before us in this appeal that it would have been obvious at the time the invention was made to a person of ordinary skill in

the art to have modified Root's inserts (i.e., cutting-plates H) to have cutting edges of different lengths<sup>4</sup>, it is our view that the only possible suggestion for modifying Root in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Since the subject matter of claim 1 is not suggested by Root for the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 5, 8 to 11 and 14 dependent thereon, under 35 U.S.C. § 103 is reversed.

**The obviousness rejection of claims 15, 16, 19, 20, 22 to 25, 27 and 28**

We will not sustain the rejection of claims 15, 16, 19, 20, 22 to 25, 27 and 28 under 35 U.S.C. § 103.

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<sup>4</sup> The appellants statement in Paper No. 9 that the variations of the inserts shown in Figures 8-10 are not separate inventions is not an admission that inserts having cutting edges of different lengths would have been obvious from inserts having cutting edges of equal lengths.

Claim 15 reads as follows:

A wire cutter, comprising:  
a first lever arm having a handle end and a cutting end;  
a second lever arm having a handle end and a cutting end;  
a pivot assembly for connecting said first lever arm to said second lever arm, said pivot assembly being located between the handle end and the cutting end of said first lever arm and said second lever arm;  
a first insert with multiple cutting edges;  
a second insert with multiple cutting edges; and  
means for non-threadedly connecting said first insert to said first lever arm and said second insert to said second lever arm.

The appellants argue that the applied prior art does not suggest the claimed subject matter of claim 15. We agree.

Claim 15 requires means for non-threadedly connecting the first insert to the first lever arm and the second insert to the second lever arm. However, Root teaches securing-screws J to connect the cutting-plates H to the members A. To supply this omission in the teachings of Root, the examiner made a determination (final rejection, p. 3; answer, p. 5) that this difference would have been obvious to an artisan.<sup>5</sup>

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<sup>5</sup> The examiner stated (final rejection, p. 3) that adhesive, force fits and other attaching means "would appear to be mechanical equivalents of screws and would, absent a showing of criticality, appear to be obvious." However, the examiner has not cited any evidence to support this statement. Moreover, even if the statement were true in general, the examiner is required to set forth reasoning as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have replaced Root's securing-screws J with an adhesive, force fit or other non-threadedly connecting means. Furthermore, the appellants do not have to establish criticality when the applied prior art does not set forth a case of obviousness of the claimed subject matter.

However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

There is no evidence in the rejection before us in this appeal that would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Root's threadedly connecting means (i.e., securing-screws J) to be a non-threadedly connecting means. Accordingly, it is our view that the only possible suggestion for modifying Root in the manner proposed by the examiner to meet the above-noted limitation stems from the impermissible use of hindsight knowledge derived from the appellants' own disclosure.

Since the subject matter of claim 15 is not suggested by Root for the reasons set forth above, the decision of the examiner to reject claim 15, and claims 16, 19, 20, 22 to 25, 27 and 28 dependent thereon, under 35 U.S.C. § 103 is reversed.

### CONCLUSION

To summarize, the decision of the examiner to reject claim 21 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 38 to 44 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claim 37 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to

reject claims 35 and 36 and 38 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 1 to 5, 8 to 11, 14 to 16, 19, 20, 22 to 25, 27 and 28 under 35 U.S.C. § 103 is reversed.

A statement pursuant to 37 CFR § 1.196(c) has been made in this decision. A time period in which the appellant may file an amendment for the purpose stated in § 1.196(c) is hereby set to expire TWO MONTHS FROM THE DATE OF THIS DECISION.

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(c)

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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